REMARKS/ARGUMENTS

In the final Office Action dated February 23, 2006, Claims 1-42 are pending, of which Claims 1-30 and 40-42 have been elected for prosecution in this application. The pending claims stand rejected for the same reasons set forth in the September 20, 2005 Office Action. In particular, Claims 1, 2, 11, and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,857,369 to Oehlenschlager, et al. Claims 1, 3, 11, 13, 21-24, and 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,950,861 to Roth, et al. Claims 4-10 and 14-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Oehlenschlager, et al. and Claims 24 and 28-30 (and now Claims 40-42) are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roth, et al. In addition, Claim 42 is rejected under 35 U.S.C. § 112, first paragraph. No basis of rejection has been provided yet for Claims 25 and 27.

First, regarding the rejection of Claim 42 under § 112, first paragraph, the Office Action states:

> The claims(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the disclosure as originally filed for "the radiation weakened adhesive consists essentially of radiation weakened polyurethane". See page 6, lines 19-20, wherein the polyurethane is listed as one of the possible materials used for the adhesive.

Office Action, page 3.

Applicant respectfully traverses. Claim 42 recites that "the radiation weakened adhesive consists essentially of radiation weakened polyurethane." Similarly, the present application discloses that the radiation weakened adhesive can be polyurethane. For example, the application states that the "bond can be formed of an adhesive such as polyurethane." Page 3, lines 11-14. If an adhesive that is polyurethane (as disclosed in the application) is radiation weakened (as also disclosed in the application), the result is a radiation weakened adhesive that consists essentially of radiation weakened polyurethane.

Further, the present application discloses specific polyurethane adhesives that, once radiation weakened as disclosed, provide a radiation weakened adhesive that consists essentially of radiation weakened polyurethane. In particular, according to the present application, the bond **32** can be formed of the solvent-based and solvent-less polyurethane adhesives from Liofol Company, a division of Henkel Adhesives, Cary, North Carolina, that are identified by product number 3649/6255 and 7975/7276, respectively. *See* page 6, lines 19-25. Indeed, the bonds formed by these adhesives, once radiation weakened as disclosed in the application, are formed of radiation weakened adhesive that consists essentially of radiation weakened polyurethane. In this regard, Applicant is submitting herewith a Declaration by the inventor of the present invention. As set forth in the Declaration, the adhesives formed of the identified products comprise polyurethane exclusively and, thus, bonds formed by these adhesives that are radiation weakened "consist essentially of radiation weakened polyurethane" as claimed. *See* Declaration of Srinivas Nomula. Accordingly, the present application does describe and support the subject matter of Claim 42, and Applicant therefore respectfully requests withdrawal of the rejection made under § 112, first paragraph.

Applicant now addresses the rejections made under § 102(b) and § 103(a). First, despite Applicant's remarks provided in the Amendment of November 30, 2005, the Office Action again states, in connection with the rejections of various claims as being anticipated by Roth, et al.:

> The 'radiation weakened bond' renders the claim to be a product-by-process claim that does not structurally limit the claim. MPEP 2113.

Office Action, page 3.

Applicant again disagrees and reiterates the previous reasons for traversal. In particular, as explained in the November 30, 2005 Amendment, the MPEP and courts have recognized that product-by-process claims are limited by and defined by the claimed process and that the determination of patentability is based on the product itself. *See* MPEP 2113, Eighth edition, revision 2 (May 2004) (citing *In re Thorpe*, 777 F.2d 695, 698.) Further, "[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product." Id. (citing *In re Garnero*, 412 F.2d 276, 279). For example, the phrase "interbonded one to another by interfusion" is capable of being construed as a structural limitation rather than a process limitation, just as other phrases including "intermixed," "ground in place," "press fitted," "etched," and "welded," have also been held to be structural limitations. *See In re Garnero* at 279. Similarly, the term "radiation weakened bond" as set forth in the present claims is also capable of being construed as a structural limitation.

In comments responding to Applicant's previous arguments, the Office Action states that this limitation does not impart structure to the claim and that "such structure, if present, is distinguishable over the applied prior art." Further, in characterizing the structure that is imparted by this term, the Office Action states:

> The claims require only that the adhesive bond be such that the closure is peelable from the associated container base portion. This peelable feature is inherently and explicitly found in the teachings of both Roth and Oehlenschlager. Thus, a radiation weakened bond does not set forth structure not found in the applied prior art of record.

Office Action, pages 4-5.

Applicant disagrees with the above assertion that the claimed term merely requires that the closure is peelable from the base portion of the container. Rather, the term "radiation weakened bond" requires that a "bond" is "radiation weakened," i.e., weakened by radiation. Applicant again refers to *In re Garnero*, where the court held that correct inquiry to be "whether the product defined by claim 1 is patentably distinguishable over the disclosures of [the prior art] in view of the structural limitation defining the panel as 'consisting essentially of expanded perlite particles * * * interbonded one to another by interfusion between the surfaces of the perlite particles.'" *Id.*

The Office Action also asserts:

> In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a radiation weakened adhesive material) are not received in the rejected claim(s).... In the instant application, Claims

> 1-7, 10-17, 20-27, and 30 require only a "radiation weakened bond". No adhesive material is set forth therein.

Office Action, page 4.

Applicant respectfully disagrees. First, with regard to the arguments set forth in the previous Amendment, Applicant did not rely on the feature of a "radiation weakened adhesive material" for any of Claims 1-7, 10-17, 20-27, or 30. Indeed, in Applicant's previous Amendment, the term "adhesive" appears only in the first paragraph of page 10, which concerns the rejection of Claims 8 and 9, dependent claims that specifically recite an adhesive.

To the contrary, Applicant previously asserted that the "radiation weakened" language of the claims provides a structural limitation that is distinguishable from a bond that has not been radiation weakened, such as is disclosed by Oehlenschlager, et al. and Roth, et al. For example, as previously explained, neither Roth, et al. nor Oehlenschlager, et al. "describes a radiation-weakened bond. Roth, et al. does not disclose any weakened connection. Oehlenschlager, et al. discloses that the fixing layer **10** is heated to form the non-oriented material, but does not disclose a radiation weakened bond that attaches a membrane to a base portion. Indeed, any radiation weakening that is performed by Oehlenschlager, et al. occurs only before formation of the bond between the fixing layer and the film. In other words, the heating operation of Oehlenschlager, et al. affects the surface of the fixing layer **10**, not any bond itself that is subsequently formed." Amendment dated November 30, 2005, page 9.

Nevertheless, Applicant has amended the independent claims above to incorporate a feature previously set forth in dependent Claims 8, 18, and 28, i.e., that the bond is formed of an adhesive. This feature further distinguishes the claims from the cited references as neither reference teaches or suggests a radiation weakened bond formed of an adhesive. In this regard, the Office Action states that, although Oehlenschlager, et al. is silent regarding the materials, it would have been obvious to use any material as a matter of obvious design choice. Office Action, page 3. Applicant respectfully disagrees. Oehlenschlager, et al. teaches that a film **2** is pressed against a fixing layer **10** and heated so that the film sticks thereto, or a heat activated adhesive is used. Oehlenschlager, et al. does not teach or suggest using radiation to weaken any such adhesive. Moreover, Oehlenschlager, et al. does not disclose using radiation to weaken a bond that has been formed of adhesive. A "heat activated adhesive" is not a radiation weakened bond that is formed of an adhesive as claimed.

In this regard, the Office Action suggests that the application of any radiation to an adhesive results in a radiation weakened bond. For example, the Office Action states:

> It is well known in the art that any heat applied to an adhesive material or to heat sealable structure is radiation applied to the adhesive and/or structure. Thus, both Roth and Oehlenschlager teach radiation weakened bonds.

Office Action, page 5.

However, Applicant notes that the mere teaching that heat can be applied to an adhesive (or to a bond) is not evidence of a radiation weakened bond. For example, a "heat activated adhesive" implies that heat is used to activate the adhesive, not that the adhesive is in any way weakened by radiation.

In any case, Oehlenschlager, et al. does not teach that radiation is applied to any bond, nor that radiation is used to weaken any bond or adhesive. Accordingly, even in light of Oehlenschlager, et al., it would not have been a mere design choice to select an adhesive that can be radiation weakened, form a bond with the selected adhesive, and then provide radiation to the bond and thereby weaken the bond. Further, Oehlenschlager, et al. specifically states that the "radiation is of a frequency or a composition selected so that the plastic material substantially prevents the radiation from passing through it." Col. 4, lines 15-18. Thus, it is unclear how any bond formed in the device Oehlenschlager, et al. could be subjected to radiation for weakening of the bond.

Accordingly, Applicant respectfully submits that Claim 1 is allowable over the cited references, as are each of the dependent Claims 2-7, 9, 10, and 40-42.

Independent Claims 11 and 21, as amended, each recite a plastic membrane that is attached to another member by a bond that is "formed of an adhesive" that has "a predetermined shear force strength and configured to be radiation weakened to have a predetermined tensile force strength." As set forth above, neither of the cited references discloses such an adhesive bond or such a bond that is configured to be radiation weakened so that the shear force strength of the bond is sufficient to withstand retort while the tensile force strength of the bond allows easy-opening.

Regarding Claims 11 and 21, the Office Action states that "Oehlenschlager sets forth a radiation weakened bond. The bond formed between the surfaces of the closure and container are effected by the heat treatment of the materials and structure associated therewith. Wherein the claims do not require the adhesive to be radiation weakened the structure of the claims are met by Oehlenschalger." Office Action, page 5.

Applicant disagrees. Oehlenschlager, et al. does not disclose a structure with a bond that is configured to be radiation weakened to allow easy opening. Indeed, Oehlenschlager, et al. does not teach or suggest that any bond, once formed, can be weakened with radiation. Instead, Oehlenschlager, et al. is specifically directed to a surface treatment and, even if the surface treatment affects the strength of the resulting bond that is ultimately formed, the bond itself is not radiation weakened or even configured to be radiation weakened. Nor does Oehlenschlager, et al. disclose (a) that the bond is formed of an adhesive that can be radiation weakened or (b) any configuration in which an adhesive bond is or can be radiation weakened as claimed. To the contrary, as noted above, Oehlenschlager, et al. specifically states that the "radiation is of a frequency or a composition selected so that the plastic material substantially prevents the radiation from passing through it." Col. 4, lines 15-18.

Thus, each of the independent Claims 11 and 21 are allowable over the cited references, as are the dependent claims.

Further, Oehlenschlager, et al. also fails to provide any teaching that the bond can be weakened to result provide the minimum tensile force strength while also providing less than the maximum shear force strength as set forth in Claim 14. The Office Action asserts that the application does not set forth any criticality for the claimed values and therefore "experimentation by one of ordinary skill in the art would lead to the values set forth in the instant claims." The Office Action does not point to any teaching in the cited references for a bond that provides disparate strength values, i.e., a minimum tensile force strength while also providing less than a maximum shear force strength, regardless of the particular values set forth in Claim 14. Moreover, the references do not teach or suggest a bond that is configured to be radiation weakened to achieve the claimed properties. Accordingly, Claim 14 is allowable for this additional reason.

For the foregoing reasons, Applicant submits that Claims 1-7, 9-17, 19-27, and 29-42 are allowable over the cited references.

Further, as noted in the Amendment of November 30, 2005, no basis of rejection was provided in the first Office Action for either of Claim 25 or 27. The second Office Action again fails to provide any basis of rejection for these claims. Accordingly, Applicant respectfully requests withdrawal of the finality of the second Office Action.

In the event that the finality of the Office Action is maintained and any of the rejections are also maintained, Applicant respectfully requests entry of the above amendments. The amendments merely incorporate into each independent claim a feature that was previously set forth in a corresponding dependent claim, and therefore the amendments do not introduce any new issues. Moreover, the amendments put the claims in better condition for appeal.

* * * *

CONCLUSIONS

In view of the remarks presented above, Applicant submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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